

**REMARKS:**

Claims 1-37 are currently pending in the application.

Claims 1-7, 9-18, 20-29, and 31-37 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 6,157,738 to Call ("*Call*").

Claims 8, 19 and 30 stand rejected under 35 U.S.C. § 103(a) over *Call* in view of U.S. Patent No. 7,272,626 to Sahai ("*Sahai*").

The Applicant respectfully submits that all of the Applicant's arguments and amendments are without *prejudice* or *disclaimer*. In addition, the Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, the Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. The Applicant further respectfully submits that by not responding to additional statements made by the Examiner, the Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by the Applicant are considered sufficient to overcome the Examiner's rejections. In addition, the Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

**REJECTION UNDER 35 U.S.C. § 112:**

The Applicant wishes to thank the Examiner for withdrawing the rejection of Claims 1-37 under 35 U.S.C. § 112, second paragraph.

**REJECTION UNDER 35 U.S.C. § 103(a):**

The Applicant wishes to thank the Examiner for withdrawing the rejection of Claims 1-6, 12-17, 23-28, and 34-37 over U.S. Patent No. 6,055,515 to Consentino *et al.* ("*Consentino*") in view of U.S. Patent No. 6,076,091 to Fohn *et al.* ("*Fohn*"). In addition, by withdrawing the rejection of Claims 1-6, 12-17, 23-28, and 34-37 over *Consentino* and

*Fohn*, the Examiner acknowledges that Claims 1-6, 12-17, 23-28, and 34-37 are patentably distinguishable over *Consentino* and *Fohn*.

The Applicant further wishes to thank the Examiner for withdrawing the rejection of Claims 7-11, 18-22, and 29-33 over *Consentino* in view of *Fohn* and in further view of U.S. Patent No. 6,789,091 B2 to Gogolak ("*Gogolak*"). In addition, by withdrawing the rejection of Claims 7-11, 18-22, and 29-33 over *Consentino* and *Gogolak*, the Examiner acknowledges that Claims 7-11, 18-22, and 29-33 are patentably distinguishable over *Consentino* and *Gogolak*..

**REJECTION UNDER 35 U.S.C. § 102(b):**

Claims 1-7, 9-18, 20-29, and 31-37 stand rejected under 35 U.S.C. § 102(b) over *Call*.

The Applicant respectfully submits that the ***amendments to independent Claims 1 and 35 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims.*** The Applicant further respectfully submits that amended independent Claims 1 and 35 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Call*. In addition, the Applicant respectfully submits that dependent claims 2-7 and 9-11 are allowable at least for the reason of their dependence from an allowable independent claim.

The Applicant further respectfully submits that independent Claims 12 and 23 in contain unique and novel limitations that are not taught, suggested, or even hinted at in *Call*. In addition, the Applicant respectfully submits that dependent claims 13-18, 20-22, 24-29 and 31-33 are allowable at least for the reason of their dependence from an allowable independent claim (claims 12 and 23, respectively). Moreover, independent claims 34, 36 and 37 likewise contain unique and novel limitations that are not taught, suggested, or even hinted at in *Call*. Thus, the Applicant respectfully traverses the

Examiner's rejection of Claims 1-7, 9-18, 20-29, and 31-37 of under 35 U.S.C. § 102(b) over *Call*.

***Call Fails to Disclose, Teach, or Suggest Various Limitations Recited in the Applicant's Claims***

For example, with respect to amended independent Claim 1, this claim recites:

A computer-implemented system for categorizing product data in an electronic commerce transaction, the system comprising:

***a data association module coupled with one or more seller databases and a global content directory server, the data association module operable to:***

access a first product classification schema, the first schema comprising a taxonomy comprising a hierarchy of classes for categorizing one or more products, the first schema further comprising ontologies associated with one or more of the classes, each ontology comprising one or more product attributes, wherein each of the one or more products is associated with a global unique identifier;

access target data to be associated with the first schema, the target data organized according to a second product classification schema;

determine one or more classes of the first schema with which at least a portion of the target data is associated based on a comparison between the target data and the product attributes of the ontologies of the first schema or between the target data and values for one or more of the product attributes of the ontologies of the first schema;

associate the at least a portion of the target data with one or more classes of the first schema in response to determining, based on the comparison, the one or more classes of the first schema with which the at least a portion of the target data is associated; and

store the values for one or more of the product attributes of the ontologies of the first schema with which the target data is compared in the one or more seller databases. (Emphasis Added).

In addition, *Call* fails to disclose each and every limitation of independent Claims 12, 23, 34, 36 and 37.

The Applicant respectfully submits that *Call* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a “**data association module**” and in particular *Call* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a “**data association module coupled with one or more seller databases and a global content directory server**”. In particular, the Examiner asserts that *Call* discloses “a computer-implemented system with method and program products for categorizing product data in electronic commerce transaction [e.g. Abstract, Fig(s). 1-5 and associated texts] as claimed by applicant, comprising the following functions.” (26 November 2007 Final Office Action, Page 2). Assuming *arguendo* the Examiner’s characterization of *Call*, which the Applicant does not admit, nowhere does *Call* disclose a “data association module.” Moreover, *Call* does not, clearly does not disclose “a data association module coupled with one or more seller databases and a global content directory server” present in the Applicant’s amended independent Claim 1.

In addition, the **computer implemented system with method and executable program product disclosed in *Call*** merely relates to a file being “placed” by a manufacturer “in the directory it creates for that product” and “in addition, the manufacturer would place a combined file, also called ‘biblio.dat’ in its root ‘upcinfo’ directory” (*Call*, Column 12, Lines 14-15, 20-21) but **does not include, involve, or even relate to a data association module coupled with one or more seller databases and a global content directory server**” as recited in amended independent Claim 1. In contrast, the “**data association module**” recited in amended independent Claim 1 is **coupled with one or more seller databases and a global content directory server**. Thus, the Applicant respectfully submits that there is no equation that exists between *Call* and amended independent Claim 1. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Call*.

The Applicant further respectfully submits that *Call* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding “**determine one or more classes of the first schema with which at least a portion of the target data is associated based on a comparison between the target data and the product**”

**attributes of the ontologies of the first schema or between the target data and values for one or more of the product attributes of the ontologies of the first schema.”** In particular, without explanation, reasoning, or support the Examiner asserts that Applicant’s above limitation is disclosed in *Call* at Column 25, lines 35-53. (26 November 2007 Final Office Action). Notwithstanding the Examiner’s conclusory assertion that *Call* discloses amended independent claim 1 limitation regarding **“determine one or more classes...based on a comparison...”** the cited portion of *Call* is silent as to **“determine one or more classes...based on a comparison”** However, **“WWW consortium search engines”** disclosed in *Call* has merely “further defined the ‘Resource Description Framework (RDF) and Syntax Specification’ as described...” and **does not include, involve, or even relate to determine one or more classes...based on a comparison**, as recited in amended independent Claim 1. (*Call*, Column 25, Lines 35-37). In fact, the WWW consortium disclosed in *Call*, has nothing to do with **“determine one or more classes...based on a comparison”** as recited in amended independent Claim 1, and even if it did, which it clearly does not, **merely further defining RDF and Syntax Specification**, as disclosed in *Call*, has nothing to do with **“determin[ing] one or more classes...based on a comparison”**, as recited in amended independent Claim 1. Thus, the Applicant respectfully submits that equations between *Call* and amended independent Claim 1 cannot be made. The Applicant further respectfully submits that the foregoing distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Call*.

### **The Office Action Fails to Properly Establish a *Prima Facie* case of Anticipation over *Call***

The Applicant respectfully submits that the allegation in the Office Action that *Call* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Final Office Action provides no concise explanation as to how *Call* is considered to anticipate all of the limitations in independent Claims 1, 12, 23 and 35. ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.*** MPEP § 2131. (Emphasis Added).

The Applicant respectfully points out that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicant respectfully submits that ***the Office Action has failed to establish a prima facie case of anticipation in Claims 1-7, 9-18, 20-29, and 31-37 under 35 U.S.C. § 102 with respect to Call because Call fails to identically disclose each and every element of the Applicant's claimed invention, arranged as they are in the Applicant's claims.***

### **The Applicant's Claims are Patentable over Call**

The Applicant respectfully submits that independent Claims 12, 23, 34, 36 and 37 are considered patentably distinguishable over *Call* for at least the reasons discussed above in connection with amended independent Claim 1.

Furthermore, with respect to dependent Claims 2-7, 9-11, 13-18, 19-22, 24-29 and 31-33: dependent Claims 2-7 and 9-11 depend from amended independent Claim 1 and are considered patentably distinguishable over *Call*; dependent Claims 13-18 and 19-22 depend from independent Claim 12 and are considered patentably distinguishable over *Call*; dependent claims 24-29 and 31-33 depend from independent Claim 23 and are considered patentably distinguishable over *Call*. Thus, dependent Claims 2-7, 9-11, 13-18, 19-22, 24-29 and 31-33 are considered to be in condition for allowance for at least the reason of depending from an allowable independent claim.

Thus, for at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-7, 9-18, 20-29, and 31-37 are not anticipated by *Call*. The Applicant further respectfully submits that Claims 1-7, 9-18, 20-29, and 31-37 are in condition for allowance. Thus, the Applicant respectfully request that the rejection of Claims 1-7, 9-18, 20-29, and 31-37 under 35 U.S.C. § 102(b) be reconsidered and that Claims 1-7, 9-18, 20-29, and 31-37 be allowed.

## **THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standard for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.

2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.

2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.

3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.

4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The

effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

**REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 8, 19 and 30 stand rejected under 35 U.S.C. § 103(a) over *Call* in view of *Sahai*.

The Applicant respectfully submits that the ***amendments to independent Claim 1 have rendered moot the Examiner's rejection of Claim 8 and the Examiner's arguments in support of the rejection of this claim.*** The Applicant further respectfully submits that independent Claims 12 and 23, from which claims 19 and 30 depend, respectively, contain unique and novel limitations that are not taught, suggested, or even hinted at in *Call and Sahai*, either individually or in combination. Thus, the Applicant respectfully traverses the Examiner's obviousness rejection of Claims 8, 19 and 30 under 35 U.S.C. § 103(a) over the proposed combination of *Call and Sahai*, either individually or in combination.

**The Proposed *Call-Sahai* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in the Applicant's Claims 8, 19 and 30**

For example, with respect to amended independent Claim 1, this claim recites:

A computer-implemented system for categorizing product data in an electronic commerce transaction, the system comprising:

***a data association module coupled with one or more seller databases and a global content directory server, the data association module operable to:***

access a first product classification schema, the first schema comprising a taxonomy comprising a hierarchy of classes for categorizing one or more products, the first schema further comprising ontologies associated with one or more of the classes, each ontology comprising one or more product attributes, wherein each of the one or more products is associated with a global unique identifier;

access target data to be associated with the first schema, the target data organized according to a second product classification schema;

determine one or more classes of the first schema with which at least a portion of the target data is associated based on a comparison between the target data and the product attributes of the ontologies of the first schema or between the target data and values for one or more of the product attributes of the ontologies of the first schema;

associate the at least a portion of the target data with one or more classes of the first schema in response to determining,

based on the comparison, the one or more classes of the first schema with which the at least a portion of the target data is associated; and

store the values for one or more of the product attributes of the ontologies of the first schema with which the target data is compared in the one or more seller databases. (Emphasis Added).

The Applicant respectfully submits that *Call and Sahai*, individually or in combination, fail to disclose, teach, or suggest amended independent Claim 1 limitations regarding ***“a data association module”*** and in particular *Call* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding ***“a data association module coupled with one or more seller databases and a global content directory server.”*** The Applicant respectfully submits that dependent Claim 8 depends from amended independent Claim 1, and is considered patentably distinguishable over *Call*, and is considered in condition for allowance for at least the reason of depending from an allowable independent claim.

#### **The Final Office Action Acknowledges that *Call* Fails to Disclose Various Limitations Recited in the Applicant’s Claims 8, 19 and 30**

The Applicant respectfully submits that the Final Office Action acknowledges, and the Applicant agrees, that *Call* fails to disclose the limitation ***“determining one or more classes of the first schema with which the at least a portion of the target data is associated comprises using statistical correlation techniques to identify portions of the target data including values that correspond to values for a product attribute included in the ontologies of these one or more classes of the first schema”*** from amended independent Claim 1. (26 November 2007 Final Office Action, Page 5).

Nevertheless, the Examiner asserts that the cited portions of *Sahai* somehow disclose the acknowledged shortcomings in *Call*. The Applicant respectfully traverses the Examiner’s assertions regarding the subject matter disclosed in *Sahai*.

The Applicant respectfully submits that *Sahai* fails to disclose, teach, or suggest amended dependent Claim 8, 19 or 30 limitations regarding a “determining one or more

classes of the first schema with which the at least a portion of the target data is associated comprises using statistical correlation techniques to identify portions of the target data including values that correspond to values for a product attribute included in the ontologies of these one or more classes of the first schema".

For example, the Examiner asserts that *Sahai* "discloses using statistical correlation techniques to identify portions of the target data including values as claimed." (26 November 2007 Final Office Action, Page 5). Notwithstanding, "using statistical correlation techniques to identify portions of the target data including values as claimed" in no way touches, deals with, or even relates to the claim 8, 19, and 30 limitation regarding "determining one or more classes of the first schema with which the at least a portion of the target data is associated comprises using statistical correlation techniques to identify portions of the target data including values that correspond to values for a product attribute included in the ontologies of these one or more classes of the first schema". Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Sahai* and dependent Claims 8, 19 and 30 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish dependent Claims 8, 19 and 30 from *Sahai*.

**The Final Office Action Fails to Properly Establish a *Prima Facie* case of Obviousness over the Proposed *Call-Sahai* Combination According to the UPSTO Examination Guidelines**

The Applicant respectfully submits that the Final Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Call* or *Sahai*, either individually or in combination, and in particular, the Final Office Action fails to establish a *prima facie* case of obviousness based on the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" (the "Guidelines").

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness

is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “**ensure that the written record includes findings of fact** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “**factual findings made by Office personnel are the necessary underpinnings to establish obviousness.**” (*id.*). Further, “**Office personnel must provide an explanation to support an obviousness rejection** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject Application, the Final Office Action has not shown the **factual findings necessary to establish obviousness** or even **an explanation to support the obviousness rejection** based on the proposed combination of *Call* and *Sahai*, either individually or in combination. The Final Office Action merely states that “it would have been obvious to **apply the statistical technique disclosed by Sahai into the system of Call.**” (26 November 2007 Final Office Action, Page 5). The Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement

is not sufficient to establish the ***factual findings necessary to establish obviousness*** and is not a sufficient ***explanation to support the obviousness rejection*** based on the proposed combination of *Call* and *Sahai*.

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “***obviousness rejection should include***, either explicitly or implicitly in view of the prior art applied, ***an indication of the level of ordinary skill.***” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided ***an indication of the level of ordinary skill.***

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.*** (*Id.*). In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.*** (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Final Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether the Applicant's invention would have been obvious to one of ordinary skill in the art. In addition, the Final Office Action fails to ***explain why the difference(s) between the proposed combination of Call and Sahai, either individually or in combination, and the Applicant's claimed invention, would have been obvious to one of ordinary skill in the art.*** The Final Office Action merely states that “the combined system will be upgraded to use the well-

known statistical correlation techniques to identify portions of the target data...such that the combined system will provide a more precise response to the user in a decentralized manner.” (26 November 2007 Final Office Action, Page 5). The Applicant respectfully disagrees and further respectfully requests clarification as to how this statement ***explains why the difference(s) between the proposed combination of Call and Sahai, either individually or in combination, and the Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** The Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “***the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.***” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on ***obviousness cannot be sustained by mere conclusory statements***; instead, there ***must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.***” (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

The Applicant respectfully submits that the ***Final Office Action fails to provide any articulation, let alone, clear articulation of the reasons why the Applicant's claimed invention would have been obvious.*** For example, the ***Examiner has not adequately supported the selection and combination of Call and Sahai to render obvious the Applicant's claimed invention.*** The Examiner's unsupported conclusory statements that "it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the statistical technique disclosed by *Sahai* into the system of *Call*", ***does not adequately provide clear articulation of the reasons why the Applicant's claimed invention would have been obvious.*** (26 November 2007 Final Office Action, Page 5). In addition, the Examiner's unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious the Applicant's claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Call* and *Sahai*, the Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an explicit analysis of the rationale relied upon by the Examiner.

***Call and Sahai, Individually and in Combination, Fail to Teach Various Limitations Recited in the Applicant's Claims***

The Applicant respectfully submits that dependent Claims 8, 19 and 30 are considered patentably distinguishable from *Call*. *Call*, as acknowledged by the Examiner, does not teach the unique and novel limitations taught in Claims 8, 19 and 30. This being the case, dependent Claims 8, 19 and 30 are considered patentably distinguishable over *Call*.

With further respect to dependent Claims 8, as mentioned above, dependent Claim 8 depends from amended independent claim 1, is considered patentably distinguishable over the *Call-Sahai* combination, and is considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant respectfully submits that Claims 8, 19 and 30 are not obvious over *Call and Sahai*, alone or in combination.. The Applicant further respectfully submits that Claims 8, 19 and 30 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 8, 19 and 30 under 35 U.S.C. § 103(a) be reconsidered and that Claims 18, 19 and 30 be allowed.

**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

19 December 2007

Date

/Steven J. Laureanti/signed

Steven J. Laureanti, Registration No. 50,274

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**CUSTOMER NO. 53184**